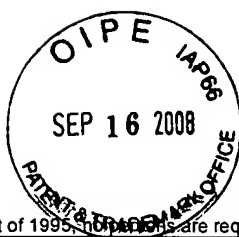


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.0756-01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/693,966

Filed

October 28, 2003

First Named Inventor

Isabelle ROLLAT

Art Unit

1614

Examiner

Zohreh VAKILI

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

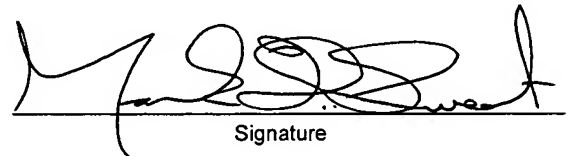
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.

Registration number 41,469

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Mark D. Sweet

Typed or printed name

202-408-4325

Telephone number

September 16, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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I. STATUS OF CLAIMS

Claims 1-16 are pending. Claims 15 and 16 are withdrawn from consideration as allegedly being drawn to a non-elected invention. No claim is amended herein.

II. REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,555,117 to Midha et al. ("Midha"). Essentially, the Examiner asserts that one of ordinary skill in the art would have been motivated to use the silicone grafted adhesive polymer disclosed in Midha as a reshapable hair styling composition. *See* Office Action dated June 29, 2007, page 12. Applicants disagree and traverse the rejection for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. *See* M.P.E.P. § 2143, 8th Edition, Rev. 6 (Sept. 2007). In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467.

Indeed, to establish a *prima facie* case of obviousness, the examiner must:

make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. The key, moreover, “to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”

M.P.E.P. § 2142. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” M.P.E.P.

§ 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Applicants respectfully submit that such articulated reasoning is not present in the rejection of record at least because no rationale is set forth why one of ordinary skill in the art would have modified the compositions of Midha to produce a reshapable hair styling composition.

Midha discloses personal care compositions, such as hair compositions. Midha discloses that “[m]any people desire a high level of style retention, or hold, from a hair spray composition.” Midha, at col. 1, lines 32 and 33. The object in Midha is to provide hair compositions, such as hair sprays, that can “provide an improved combination of hair hold and hair feel characteristics.” *Id.*, at col. 1, lines 38-41. Notably, there is absolutely no disclosure in Midha regarding a hair composition having a reshapable effect.

A composition with at least one acrylic copolymer described in the claims may or may not have a reshapable effect. *See* Applicants’ specification at page 19, lines 1-7. As explained in the specification, a “reshapable” hair styling composition means a hair styling composition

providing a hair styling that can be restored or modified without new material or heat being applied to the hair. *Id.* at page 5, lines 2-8. In particular, a reshapable hair styling composition permits both (1) the original hair styling to be restored after brushing and (2) the creation of a new hair styling after brushing, which may also be restored after additional brushing. *Id.* at page 18, lines 17-20.

Reshapable hair styling compositions are in sharp contrast to the traditional hair styling compositions of the prior art, such as hair sprays, gels, and mousses, which fix the hair in a single position and do not permit restyling. *Id.* at pages 1-2. Accordingly, Applicants submit that the reshapable property limitation is an appropriate basis to distinguish the claimed composition over the composition disclosed in Midha. *See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1435, 7 U.S.P.Q. 2d 1129, 1133 (Fed. Cir. 1988) (noting that “[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”).

The hair care compositions of Midha are traditional hair styling compositions that do not permit restyling. In fact, the object in Midha is to provide hair compositions, such as hair sprays, that can provide an improved combination of hair hold and hair feel characteristics, which has nothing to do with reshapable styling. *See* Midha, col. 1, lines 38-59.

Additionally, the rejection of record fails to establish how one of ordinary skill in the art would have been led to produce such a reshapable effect from the teaching of Midha. In fact, the only statement in the § 103(a) rejection regarding the claimed reshapable effect is found on page 13 of the Office Action dated June 29, 2007: “It would have been obvious to one having skill in the art at the time the invention was made to have modified the teaching of Midha et al. for the reshapable hair styling composition.” No rationale is set forth to support the Examiner’s

conclusion, and Applicants submit that none can be found in Midha, which is silent with respect to reshapable effect. Moreover, the conclusory statement quoted above is precisely the type of statement that is expressly prohibited by the Federal Circuit in *In re Kahn* and the Supreme Court in *KSR*. Such conclusory statements can simply not support a rejection on obviousness. Therefore, contrary to the Examiner's assertion, it would not have been obvious to modify the hair composition in Midha to have a reshapable styling effect, and the Examiner has not and can not point to any reasoning in the reference to show otherwise.

In the Final Office Action dated April 16, 2008, the Examiner asserts that "Midha's composition does have a reshapable effect." *Id.* at page 3. In addition, the Examiner asserts that "a reshapable hair styling composition is an intended use" and does not carry any patentable weight. *Id.* Applicants respectfully disagree.

As discussed above, Midha is silent with respect to reshapable effect and, the Examiner must agree that Midha is deficient in this respect otherwise the claims would be rejected under § 102, not § 103. Moreover, even if the composition in Midha comprises at least one acrylic copolymer, the composition would not necessarily have a reshapable effect. *See Applicants' specification at page 19, lines 1-7.*

In addition, Applicants point out the that the "reshapable effect" is a limitation appearing in the body of independent claim 1. Specifically, claim 1 as originally filed recites "where said composition provides a reshapable effect." Thus, the limitation, recited in the body of the claim, further defines the claimed composition, and must be considered by the Examiner. This limitation is a fundamental characteristic of the claimed invention that the Examiner can not simply dismiss. The rejections of record, however, attempt to do just that.

For at least the above reasons, Applicants submit that the Examiner has failed to establish that the claimed invention is *prima facie* obvious based on Midha. Accordingly, Applicants respectfully request that this rejection be withdrawn.

III. CONCLUSION

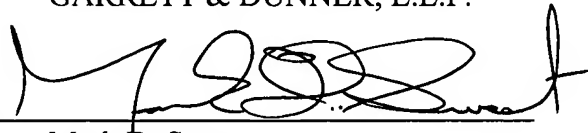
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 16, 2008

By: 
Mark D. Sweet
Reg. No. 41,469